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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,730	01/24/2001	Steve Buckley	YOR92000694US1	2263

30743 7590 09/22/2004

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EXAMINER
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NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/767,730

Applicant(s)

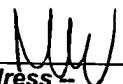
BUCKLEY ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1-17 (method<sup>1</sup>), 18-22 (method<sup>2</sup>), 35-42 (a machine readable medium) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

2. In the present case, claims 1-17 are directed to "A method of providing business solutions over an interactive communication medium", which is not within one of the classes of invention set forth in § 101.

The "A method of providing business solutions over an interactive communication medium" comprising the steps of (a) selectively providing metrics ... industry, (b) providing a business solution ..., as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "A method of providing business solutions over an interactive communication medium" comprising the steps of (a)-(b) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (integration of computer/computer automation/computer network in the body of the claim, etc.) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31

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USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

3. In the present case, claims 18-22 are directed to "A method of providing business solutions over an interactive communication medium", which is not within one of the classes of invention set forth in § 101.

The "A method of providing business solutions over an interactive communication medium" comprising the steps of (a) identify a specific industry, (b) ..., (c) ...., and (d) providing a business solution ...., as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "A method of providing business solutions over an interactive communication medium" comprising the steps of (a)-(b) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (integration of computer/computer automation/computer network in the body of the claims, etc.) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

4. In the present case, claims 35-42 are directed to "A machine readable medium containing code for providing business solutions over an interactive communication medium", which is not within one of the classes of invention set forth in § 101.

The "A machine readable medium containing code for providing business solutions over an interactive communication medium" comprising the steps of: (a)

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selectively providing metrics ... industry, (b) providing a business solution ..., as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "A machine readable medium containing code for providing business solutions over an interactive communication medium" comprising the steps of (a)-(b) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (integration of computer/computer automation/computer network in the body of the claims, etc.) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-17 (method<sup>1</sup>), 23-28 (apparatus<sup>1</sup>), 35-42 (software product<sup>1</sup>), 18-22 (method<sup>2</sup>), 29-34 (apparatus<sup>2</sup>), are rejected under 35 U.S.C. 102(e) as being anticipated by CALVER (US 2001/003 2092).**

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**As for Independent Method claim 1**, CALVER discloses a method for providing business solutions over an interactive communications medium, comprising the steps of:

(a) selectively providing metrics (questions) which are associated with a business problem and a specific industry {see Fig. 3, 16, 0054, 0060, 0061, 0062}; and

(b) providing a business solution based on the selective metrics and responses to the selective metrics {see Figs. 3, 16, 0054, 0060, 0062, 0063, 0075}.

**As for dep. claim 2** (part of 1), which calls for a specific business criteria/measure, i.e. inventory, revenue, etc., this is shown on Fig. 15, 16, 0054 or 0138.

**As for dep. claim 3** (part of 1), which calls for a specific industry code which is well known in industry, this is taught in {0056, 0057, 0071 or 0072}.

**As for dep. claim 4** (part of 1), which calls for a general business solution, this is taught in {Fig. 16, 0054, 0070-0071}.

**As for dep. claims 5-7** (part of 1), which calls for the provision of general business solution based on a set of rules, type of solution and ranking of solution, these are inherently taught in {[0053-0058, or 0138-0142, Fig. 15-16]} to provide a real useful, targeted solutions that take my business to the next level, or reduce my costs or grow my business or protect my businesss.

**As for dep. claim 8** (part of 1), which calls for the storing of the input information, this is inherently included in Figs. 2-5.

**As for dep. claim 9** (part of 1), which calls for a specific business criteria/measure, i.e. inventory, revenue, etc., this is shown on Fig. 15, 16, 0054, 0085 "revenue of 1.8 million", or 0138.

**As for dep. claim 10** (part of 1), this is taught in [0052, 0060, 0061 or 0062].

**As for dep. claim 11** (part of 1), this is taught in [0060, 0062, 0070 or 0071].

**As for dep. claims 12-14** (part of 1), which deals with types of rules for determining next question, i.e. based on the previous answer, or duplicate of previous answer, etc., these are inherently included in the teachings of [0060-0063, 0069-0076] in order to obtain targeted and useful information.

**As for dep. claim 15** (part of 1), which deals with type of metrics, i.e, quantitative metrics, this is inherently included in Fig. 15, 16, [0070-0071, 0138-0142].

**As for dep. claim 16** (part of 1), which deals with type of answer, i.e, financial analysis, this is shown in Fig. 15, 16, [0057, 0072, 0085, 0138-0142].

**As for dep. claim 17** (part of 1), which deals with well known/conventional type of financial analysis, i.e, ROR, ROI or ROA, this is shown in Fig. 15, 16, [0057, 0072, 0085, 0138-0142].

7. **As for Independent Method claim 18**, it has similar limitations as in claim 1 and 2 above and is therefore rejected for the same reason set forth in claims 1-2 above.

**As for dep. claim 19, 20, 21, 22** (part of 18), which have similar limitations as in dep. claims 5, 7, 12, 16, respectively, they are rejected for the same reasons set forth in claims 5, 7, 12, and 16 above to avoid duplication writing of rejection.

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8. **As for Independent Apparatus claim 23**, which is merely system (or means for) to carry out the steps of Method claim 1 above, it is rejected over the means to carry out the method/steps of claim 1 above as taught by CALVER above (substituting “means for” for “step of”).

**As for dep. claim 24** (part of 23), it's rejected for the same reason as in dep. claim 2 above.

**As for dep. claims 25-27** (part of 23), they are rejected for the same reasons set forth in claim 5 above.

**As for dep. claim 28** (part of 23), it's rejected for the same reason set forth in claim 16.

9. **As for Independent Apparatus claim 29**, which is merely system (or program modules) to carry out the steps of Method claim 18 (or 1 and 2) above, it is rejected over the means to carry out the method/step of claim 18 above as taught by CALVER above (substituting “module” for “step of”). Note that the teaching of CALVER is carried out using the Internet or web (see Fig. 16 for summary), so program modules are inherently included to carry out any steps {as discussed in “Architecture”, [0119-0130]}.

**As for dep. claim 30** (part of 29), it's rejected for the same reason as in claim 15 above.

**As for dep. claim 31** (part of 29), it's rejected for the same reasons set forth in claim 16 above.

**As for dep. claim 32** (part of 29), it's rejected for the same reasons set forth in claims 13-14.



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**As for dep. claim 33 (part of 29), it's rejected for the same reason set forth in claim 15.**

**As for dep. claim 34, this is shown in Figs 15-16.**

10. As for the machine readable medium containing code in **claims 35-42** for carrying out the method of claims 1, 2, 4, 7, 8, 12, 15, 16, respectively, they are rejected for the same reason set forth in claims 1, 2, 4, 7, 8, 12, 15, and 16, respectively. Note that the teaching of CALVER is carried out using the Internet or web (see Fig. 16 for summary), so program modules are inherently included to carry out any steps {as discussed in "Architecture", [0119-0130]}.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**12. Claims 5-7, 11-14 (2<sup>nd</sup> time), 20-22, 38-42, 25-28, 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over CALVER in view of FRIEDMAN.**

The teachings of CALVER is cited above. As for dep. claims 5-7, 11-14, 20-22, 38-42, 25-28, and 32-33 FRIEDMAN discloses the benefits of optimization of specific problem parameters or variables and different rules based model on Figs. 2-3, col. 4, lines 10-40, col. 6, lines 45-62. It would have been obvious to modify the teachings of CALVER by using rules based model as taught by FRIEDMAN to obtain the benefits of optimization of the specific problem parameters or variables. Note that the use of other

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similar or equivalent mathematical model or rules based would have been obvious as mere using other similar or equivalent model or rules to achieve similar results. Note that on Figs. 2-4, FRIEDMAN fairly teaches the concept of optimization of the desired business parameters, i.e. resource allocation, direct transportation cost, network problems, inventory, sequential policy, generic model, queuing theory, etc.

### ***Response to Arguments***

13. Applicant's arguments filed 6/4/04 have been fully considered but they are not persuasive.

Applicant's argument with respect to the 101 rejection is noted, however, applicant's comment that the phrase "interactive communication medium" in the preamble of the claims in dispute is clearly a machine system is not persuasive because:

1) Limitations on a preamble of a claim carries little patentable weight. The limitation has to be in the body of the claim to receive patentable weight.

2) the phrase "interactive communication medium" is broad and can read over calling a consultant and ask question and receiving answer or mailing/faxing a consultant a question and receiving answer or feedback. If applicant's opinion that the phrase refers to a machine system, then applicant is requested to insert that with other improvement functions to carry out the claimed invention as shown on page 2, line 23 to to page 3, line 14.

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14. Applicant's arguments with respect to the 102/103 rejections of claims 1-42 over FRIEDMAN have been considered but are moot in view of the new ground(s) of rejection.

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15. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113. Applicant can also review the status of the application from the Patent Application Information Retrieve (PAIR) system, see <http://pair-direct.uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053, personal Right Fax at (703) 872-9674. My work schedule is normally Monday through Friday from 6:30 am through 4:00 pm with every 1<sup>st</sup> Friday of the bi-week off.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9327. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn  
September 20, 2004

  
**DEAN T. NGUYEN**  
**PRIMARY EXAMINER**